

**REMARKS**

This application has been reviewed in light of the Office Action mailed on April 16, 2004. Claims 1 to 10 are pending in this application. Claim 1 has been amended to define still more clearly what Applicants regard as the invention, in terms that distinguish over the art of record. Favorable reconsideration is requested.

**Disclosure Objection**

The Examiner has objected to the disclosure, requiring correction of paragraph 0001 to reflect the United States patent number of the parent case, and the correct spelling of -- MacPherson -- in claim 1. Both amendments have been made.

**Claim Rejections – 35 U.S.C. § 112**

Claims 1 to 8 stand rejected under 35 U.S.C §112 as being allegedly indefinite because of the inclusion of the term “in various predetermined positions” in line 7 of independent claim 1.

The Applicants respectfully submit that the term “various predetermined positions” is neither vague nor unclear in the context of immobilizing a first turn of the spring on and with respect to the lower spring retainer. Applicants note that the same term is used in the same context in claim 1 of the parent case, U.S. Patent No. 6,612,553 B1. Nonetheless, in an earnest effort to advance this application toward allowance, Applicants have amended claim 1 to substitute -- plurality of-- for the word “various”.

**Claim Rejection – Double Patenting**

Claims 1 to 10 stand rejected under the judicially created doctrine of obviousness – type double patenting in view of claims 1 - 9 of U.S. Patent No. 6,612,553 B1. In response to this rejection, Applicants provide herewith a Terminal Disclaimer disclaiming the terminal part of the

statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full term of the prior Patent No. 6,612,553 B1.

**Claim Rejections - 35 U.S.C. §103**

Claim 1 stands rejected as being allegedly unpatentable over U.S. Patent No. 4,474,363 ("Numazawa et al.") in view of DE 893,760 ("Muller"). Claims 2-10 are objected to as being dependent on a rejected base claim. The Examiner has noted that the application names joint inventors. In considering the patentability of the claims under 35 U.S.C §103(a), the Examiner has presumed that the subject matter of the claims was commonly owned at the time the inventions were made. The Examiner is correct in that presumption.

The Examiner asserts that the prior art of Numazawa et al. discloses.

as shown in fig. 1-2, a MacPherson strut for a MacPherson wheel suspension, comprising a shock absorber 13 with a body 10 and a rod 1; said rod being surrounded by a coil spring 14, said coil spring being mounted between a lower spring retainer 18 non-pivotally secured to the shock absorber body and an upper spring retainer 40 through which the rod passes; wherein said strut comprises means 56 capable of immobilizing a first turn of the spring on and with respect to the lower spring retainer.

The Examiner contends that, although Numazawa et al. is "silent" with respect to immobilizing the first turn of the spring in various predetermined positions on the lower spring retainer, Muller teaches the missing element. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to utilize (a) the Muller means for immobilizing the first turn of a spring in various predetermined positions in (b) the Numazawa et al. wheel suspension to (c) "adjust the height or distance between the upper and lower spring retainer for the desired spring tension."

Applicants respectfully traverse the rejection and submit that pending independent claim

1 and dependent claims 2 to 10 are patentably distinct from the prior art for at least the following reasons.

### **The Claimed Invention**

Amended claim 1 covers a MacPherson strut for a MacPherson wheel suspension. The strut comprises a shock absorber with a body and a rod, the rod being surrounded by a coil spring. The spring is mounted between a lower spring retainer which is non-pivotally secured to the shock absorber body and to an upper spring retainer through which the shock absorber rod passes. The strut further comprises means capable of immobilizing the first turn of the spring on and with respect to the lower spring retainer in a plurality of predetermined positions on the lower spring retainer. The predetermined positions define a direction of translation that allows adjustment of an inclination of the spring with respect to an axis of the shock absorber.

Applicants' claimed invention is not suggested by the combination of Numazawa et al. and Muller.

### **The Cited Prior Art**

Numazawa et al. discloses a suspension for an automobile which permits adjusting the car height. The car height-adjusting mechanism operates by compressing, to a greater or lesser degree, the spring of the strut. This is accomplished by rotating, about the longitudinal axis of the rod of the shock absorber, a guide 34 having a thread on an outer periphery and on which is screwed a movable member 46 which is secured fixedly to an upper seat 50 which holds the upper end of the coil spring 14 of the strut.

Mueller discloses a means for adjusting the length L between the lower retainer 16 and the upper retainer 15 of the spring 10. This is accomplished by rotating the lower end of the

spring 10 about the axis thereof relative to the lower retainer 16 which has a helical bearing surface provided with a number of holes 17 for receiving selectively a bent end of spring 10. The holes 17 are located on a circle, the center of which lies on the lower retainer axis which also corresponds to the spring axis and the shock absorber axis.

### **There Is No *Prima Facie* Case Of Obviousness**

The Numazawa et al. and Muller references do not support a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the combined references must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and must not be based on the applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991); MPEP § 2142.

In this case there is no suggestion or motivation in either of the cited references to combine selective portions of the two patents to arrive at Applicants' invention. The Numazawa et al. and Muller patents do not address the problem to which the instant invention is directed, i.e. controlling (by minimizing) the sheer force which is applied in use on the shock absorber rod and the moment of the forces applied by the spring about the pivot axis of the strut. *See e.g.*, instant specification paragraphs 0003-0006 and 0030.

Neither Numazawa et al.'s nor Muller's means of adjustment allows the angle of the spring relative to the shock absorber axis to be modified. In Numazawa et al., when the guide 34

is rotated about the rod axis of the shock absorber 10, the mobile element 46, upper seat 50 and spring upper end are moved axially relative to the shock absorber axis, and the inclination of the spring 14 is not modified. Similarly in Muller, when the lower end of the spring is rotated about the axis of the spring, which is also the axis of the shock absorber 18, the inclination of the spring 10 relative to the axis of the shock absorber 18 is not modified, no matter which hole 17 is selected for engagement of the bent end of the spring.

When prior art references require selective combinations to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 & n.14, 221 USPQ 929, 933 & n. 14 (Fed. Cir. 1984). "Critical to the analysis is an understanding of the particular results achieved by the new combination." Interconnect Planning Corp., 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). The invention of the instant application achieves the particular result of adjusting the inclination of the spring with respect to the axis of the shock absorber. There is nothing in the cited prior art to suggest that a person seeking to solve this problem would be successful if he or she were to combine selected portions of the cited prior art apparatus which were developed to achieve different purposes.

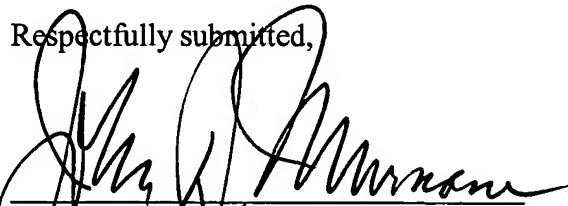
Accordingly, Applicants submit that Claim 1 is patentable over the cited art, and respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a). The other claims in the present application depend from Claim 1 and therefore are submitted to be patentable for at least the above reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, individual consideration or reconsideration, as the case may be, of the patentability of each claim on its own merits is respectfully requested.

CONCLUSION

The present Amendment is believed to place this application in condition for allowance. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicant's undersigned attorney in an effort to resolve such matters and advance the case to issue. In view of the foregoing amendments and remarks, Applicants earnestly solicit favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorneys may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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